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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,922	03/05/2002	Sheldon Breiner	004106.P003D	7871

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 09/07/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,922

Applicant(s)

BREINER, SHELDON

Examiner

Douglas B Blair

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,304,898 to Shiigi et al..
3. As to claim 19, Shiigi teaches a computer readable medium having a program stored thereon, the program being readable by a processor of a computer to execute the method comprising: transmitting a message to an ISP (col. 6, lines 53-55, a mail gateway can be considered part of any ISP); transmitting the message from the ISP to a pre-designated SDS (col. 6, lines 56-64, IMAP server is considered an SDS); and transmitting the message from the SDS to a recipient selected by a user of the computer (col. 6, lines 56-64).
4. As to claim 20, Shiigi teaches a computer readable medium of claim 19 wherein the method further comprises receiving a signal through a port of the computer, the signal including information of a note created in freehand, the message being sent to the ISP, SDS and recipient including the information of the note created in freehand (col. 5, lines 34-57).
5. As to claim 21, Shiigi teaches the computer readable medium of claim 19, further comprising: transmitting rendering code together with the message to the recipient computer, the

rendering code creating an image of the message on a screen of the recipient computer (col. 6, lines 56-64, the Handwriting Java Client applet).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 22-25, 27-29, 31, and 33-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,304,898 to Shiigi et al. in view of U.S. Patent Number 6,360, 221 to Gough et al..

8. As to claim 22, Shiigi teaches a computer readable medium having a program stored thereon, the program being readable by a processor of a computer to execute the method comprising: a routing submodule which transmits a message from the user computer through an ISP to a SDS preselected by the routing submodule, the message being capable of being transmitted from the SDS to a recipient computer corresponding to an Internet address selected by the user (col. 6, lines 53-64); however Shiigi does not explicitly teach a recipient address submodule, including a plurality of Internet addresses, one of which is selectable by a user.

Gough teaches a recipient address submodule, including a plurality of Internet addresses, one of which is selectable by a user (col. 5, line 40-col. 6, lines 11).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Shiigi regarding the transmission of email with

Art Unit: 2142

the teachings of Gough regarding the use of an address lists because such lists make it easy for email users to send email to other users (Gough, col. 5, line 40-col. 6, lines 11).

9. As to claims 23-24, 29, 31, 33-34, and 48-49, they feature the same limitations as claim 21 and are rejected for the same reasons as claim 21.

10. As to claims 25 and 35, Shiigi teaches a receiving module to receive a signal through a port of the user computer, the signal including the message.

11. As to claim 27, it features the same limitations as claim 22 and is rejected for the same reasons as claim 22.

12. As to claim 28, Gough teaches a plurality of Internet addresses residing on a user computer (col. 5, line 40-col. 6, line 11).

13. As to claim 36, Gough teaches adding a component to a message at the mail server, the component automatically displaying with the message on a screen of the recipient computer (col. 15, lines 53-65).

14. As to claims 37 and 38, Gough teaches the component being sound and graphics (col. 15, lines 53-65).

15. As to claim 39, Gough teaches the graphic being a border (Figure 12 shows a border).

16. As to claim 40, Gough teaches executing an instruction on the message to cause adding an image representing hyperlink to a third party's websites (see Figure 3, number 40').

17. As to claim 41, Gough teaches the instruction executed while the message is in the mail server (col. 7, lines 14-24).

18. As to claim 42, Gough teaches the instruction of claim 40 depending upon user preferences (col. 6, lines 12-39, paid memberships can omit advertising.).

Art Unit: 2142

19. As to claims 43 and 44, Gough teaches adding a link directing a recipient computer browser to a site having commercial information (col. 6, lines 12-39).

20. As to claim 45, Gough teaches commercial information including an article for sale (see Figure 3, number 40'). The Shiigi-Gough combination teaches the computer-readable medium having a program stored thereon which is readable by a processor of a user computer (See the rejection of claim 22).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding a link to an article for sale with the teachings of Shiigi-Gough regarding the computer-readable medium having a program stored thereon which is readable by a processor of a user computer of claim 22 because such a computer-readable medium having a program stored thereon which is readable by a processor of a user computer can be considered an article for sale.

21. As to claims 46 and 47, Shiigi teaches a message that when received by a recipient computer includes data of a note created in freehand in a form which allows the creation of a freehand reproduction to be displayed by a display device of the recipient computer (col. 5, lines 34-57).

22. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,304,898 to Shiigi et al. in view of U.S. Patent Number 6,360, 221 to Gough et al. in further view of U.S. Patent Number 6,396,481 to Challa et al..

23. As to claim 26, the Shiigi-Gough combination combines to make claim 25 obvious; however the Shiigi-Gough combination does not explicitly teach including a date with a freehand note.

Challa teaches including a date with a note created in freehand (col. 10, lines 1-55).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Shiigi-Gough combination regarding the transmission of email with the teachings of Challa regarding including a date with a note created in freehand because the inclusion of a date would help in organizing freehand notes (Challa, col. 10, lines 1-55).

24. Claims 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,304,898 to Shiigi et al. in view of U.S. Patent Number 6,360, 221 to Gough et al. in further view of U.S. Patent Number 6,721,784 to Leonard et al..

25. As to claim 30, the Shiigi-Gough combination combines to make claim 29 obvious; however the Shiigi-Gough combination does not explicitly teach the rendering code transmitted from the user computer.

Leonard teaches the transmission of rendering code from a user computer (col. 21, lines 53-67 and col. 22, lines 1-5).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Shiigi-Gough combination regarding the transmission of email with the teachings of Leonard regarding the transmission of render code from a user computer because transmitting rendering code from a user computer eliminates any need to rely on the server (Leonard, col. 21, lines 53-67 and col. 22, lines 1-5).

26. As to claim 32, Shiigi teaches generating a signal of a curve in freehand written by a user on a sheet, the signal being received through a port of the user computer and including data of the curve in freehand (Figures 7A and 7B illustrate curves).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair
August 26, 2004

DBB

Jack Harvey
JACK B. HARVEY
SUPERVISORY PATENT EXAMINER